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PATENT
Attorney Docket No. 5725.0572
Customer No. 22,852

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

David W. CANNELL et al.

Serial No.: 09/576,800

Filed: May 23, 2000

For: THE USE OF PLANT EXTRACTS IN A COSMETIC COMPOSITION TO PROTECT KERATINOUS FIBERS

Group Art Unit: 1651

Examiner: M. Flood

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In response to the Office Action dated February 8, 2001, Applicants respectfully request reconsideration of this application in light of the following remarks. In the Office Action, the Office requires restriction under 35 U.S.C. § 121 to one of the following groups of claims:

Group I: claims 1-13, directed to a method of protecting keratinous fiber from extrinsic damage comprising applying to said keratinous fiber a composition comprising at least one plant extract chosen from potato extract, mistletoe extract, avocado extract, wheat germ extract, and willowherb extract;

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Group II: claims 14-27, directed to a method of improving combability and/or curl formation of keratinous fiber comprising applying to said keratinous fiber a composition comprising at least one plant extract; and

Group III: claims 28-38, directed to a composition for treatment or protection of keratinous fiber, said composition comprising at least one willowherb extract and at least one sugar.

The restriction requirement is respectfully traversed. However, to be fully responsive to the restriction requirement, Applicants elect, with traverse, the subject matter of Group I, claims 1-13. Applicants initially traverse the restriction requirement on the grounds that the Office has not shown that there would be a serious burden to examine the claims of Groups I-III together.

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent or distinct as claimed; and

(B) There must be a serious burden on the Examiner if restriction is required (*see* M.P.E.P. § 803.02, § 806.04(a) - § 806.04(i), § 808.01(a), and § 808.02). *See* M.P.E.P. § 803. Thus, if the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions. *Id.*

Applicants respectfully submit that a search of the subject matter of Groups II and III, in addition to the subject matter of Group I, would not be seriously burdensome

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because a proper search of the subject matter of Groups II and III would necessarily encompass the search of the subject matter of Group I. The claims in Group I recite a method using a composition comprising at least one plant extract chosen from a specific list, including willowherb extract, those of Group II recite a method using a composition comprising at least one plant extract, and claims in Group III are drawn to a composition comprising at least one willowherb extract. In addition, all the Groups are classified in the same class, and Groups I and II are in neighboring subclasses.

Furthermore, in the hair art, at least claims directed to a compound and claims directed to a method of using said compound have historically been examined together in the same application. This fact is demonstrated by U.S. Patent Nos. 5,510,120 and 4,518,517, cited in the Information Disclosure Statement filed June 26, 2000. For these reasons, Applicants respectfully submit that no serious burden exists to examine the claims of Groups I-III together.

In view of the foregoing remarks, Applicants respectfully submit that the restriction requirement is in error and request that the requirement be withdrawn.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account Deposit Account No. 06-0916.

Respectfully submitted,

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